



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,966	07/19/2001	Christopher McCormick	ELT-002 (6281/6)	6828
21323	7590	08/25/2004	EXAMINER	
TESTA, HURWITZ & THIBEAULT, LLP HIGH STREET TOWER 125 HIGH STREET BOSTON, MA 02110			SUHOL, DMITRY	
			ART UNIT	PAPER NUMBER
			3712	

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/908,966

Applicant(s)

MCCORMICK ET AL.

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-32 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

This application contains claims 13-20 drawn to an invention nonelected with traverse in Paper No. 9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chao et al '632 in view of Lippman '042 and Boe et al '975. Chao discloses a method for facilitating private instruction over a network containing most of the elements of the claims including with reference to claim 21, receiving profile information associated with a student from a first client system (student client computer 554 and cols. 4-5, lines 61+and 1-5, respectively), registering, by a server system, a student in a course based in part on information received (read onto the storing/registering information in medium 108 of the server 550 as described in col. 4, lines 5-10) and arranging profile information associated with a registered student in a queue having different profile information (categorization of information presented as described in col. 4, lines 61+). A

Art Unit: 3712

first and second client systems exchanging information independently of the server system, as required by claim 21, is taught in col. 6, lines 13-15. The first and second client systems being in different time zones, as required by claim 22, is taught in col. 2, lines 61+. A second client system being operated by the teacher of the course, as required by claim 24, is taught in col. 7, lines 4-7. The second client system being operated by an administrator, as required by claim 25, is taught in col. 3, lines 66-67. The profile information of the student identifying the preferred time of day of the week for exchanging messages, as required by claim 26, is taught in col. 5, lines 1-2. Profile information arranged within the queue corresponding to students awaiting teacher assignments, as required by claim 27, is described in col. 4, lines 61+. Messages exchanged between the first and second client systems being at least one of electronic mail, voice mail, and text messages as required by claims 28 and 31 is described in col. 6, lines 14-16. The course being intended to teach a language that is not native to the student, as required by claim 29, is taught in col. 2, lines 61+. Transmitting by the server web page information associated with the course to the first client system, as required by claim 32, is taught in col. 4, lines 30-36.

Although Chao discloses most of the elements of the claims, the reference fails to explicitly teach the step of transmitting, by a server system, a placement test to the first client system via a network as required by claims 21 and 23, the step of removing the arranged profile information associated with the registered student from the queue in response to selection indicia received from a second client system as required by claim 21, forming by the server system an electronic mail account as required by claim

Art Unit: 3712

30. However, Lippman discloses a computerized test system which teaches that is known to provide tests (including placement tests) to a client system through a server (see abstract) in a network environment. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have utilized a practice test transmitted by a server system to the a client system via a network, in the system of Chao, since Chao clearly states that one of the items in the profiles submitted by the users/students are the level of skill in the subject matter (col. 4, lines 65-66).

Regarding the removal of arranged profile information step, Boe discloses a computerized system which matches potential clients with businesses through the uses of profile information gathered in a network environment which teaches that it is known remove the profile information in response to the selection of the information by a client system (col. 8, lines 6-9). Therefore it would have been obvious to remove the user profile information associated with a registered student from the queue in the system of Chao in response to selection indicia received from a second client system for the purpose of providing security to the user and his/her associated information.

The formation of an electronic mail account by the server system would have been obvious in the system of Chao since Chao clearly discloses that email is a form of communication encompassed with his invention (col. 6, lines 14-16) and since examiner takes official notice that formation of electronic mail accounts in computerized systems utilizing a network is notoriously well known and since applicants specification clearly states that an email account may be created if the user/teacher does not have one already (page 4, paragraph 0041).

Response to Arguments

Applicant's arguments filed May 27th 2004 have been fully considered but they are not persuasive. Applicants argue that the newly added method steps of "transmitting, by a server, a placement test to the first client system via a network and registering, by the server system, the student in a course based, at least in part, on responses to the placement test received from the first client system" render the claims unobvious. In response the examiner point to the above rejection and points out that Chao, as stated above, clearly envisions that the registration for his classes be based in part upon the students skill level (col. 4, lines 65-66). Therefore applicants arguments are not convincing.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3712


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ds


DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700